

PATENT APPLICATION

CUSTOMER NO. 27460

10/085,781

## REMARKS:

In an earnest effort to advance prosecution of this case, Applicant has amended the claims and submits the following remarks for the Examiner's reconsideration of this case.

Claim Rejection, Section 112

Claim 20 has been rejected for failure to provide antecedent basis for the term "computer program." Claim 20 has been amended to depend from claim 19, thereby obviating this problem.

Claim Rejection, Section 103

a. Claims 1-5 and 8-10 stand rejected under Section 103 as being unpatentable over Rivette et al in view of Rofrano. Claim 1 has been amended to incorporate the limitations of claim 6, thereby overcoming this rejection. Applicant respectfully submits that claim 1 is now allowable. Similarly, since claims 2-5 and 8-10 depend from amended claim 1, claims 2-5 and 8-10 are now allowable by definition.

b. Claims 6 and 11-18 stand rejected under Section 103 as being unpatentable over Rivette et al in view of Rofrano and further in view of Hoffer. Claim 6 has been canceled, thereby making this rejection moot with respect to claim 6. However, since the limitations of claim 6 have been incorporated into claim 1, Applicant submits the following remarks indicating that claim 1, as currently amended, is allowable over the art of record. More specifically, Applicant respectfully submits that (i) no motivation is present in the art to make the combination suggested by the Examiner; (ii) any combination of the art as suggested by the Examiner would fail to provide the results suggested by the Examiner; (iii) any reasonable combination of the cited art would fail to disclose the invention as cited in claim 1; and (iv) any combination of the art as suggested by the Examiner would fail to function and provide the results of the invention as recited in claim 1.

As a preliminary matter, Applicant notes that the art cited by the Examiner in the subject Office Action falls under two groups: Group A – art which generally describe catalogues (Rivette, Rofrano, Povilus, and Hartman) and Group B – art which generally

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describe or make use of the HTS (Hoffer and Pool). In Group A, a catalog is created which enables a user to enter various keywords and obtain a selection of hits from the catalogue. The end result is not a classification of the user's item, but rather a list of item and the user then can make a selection of which item is of interest. In Group B, systems are described which require, among others, identification of the appropriate HTS classification of a particular item. However, no explanation is provided as to how such an identification can be made. At the most that can be said about combination of references from Group A and Group B is that such a combination would result in a digitized catalogue of the HTS. This indeed has been done and was alluded to in the subject Application (see, e.g., Paragraph 0006 of the subject Application). However, as described in the subject Application, such a digitization still doesn't solve the problem of the need for a customs professional to assist an importer in arriving at the correct HTS classification for an item. Notably, Government regulations mandate that the importer correctly identify the correct HTS classification for every item imported or ECCN classification for items exported. However, the published HTS and ECCN do not contain every item a person may wish to import/export. Therefore, importers/exporters habitually use import/export brokers to assist in determining the correct classifications.

For example, Pool describes a system for international transaction. For full implementation of such a system, Pool suggests that "technological advances" may be needed for an efficient implementation of the system [Cl. 13, ln. 45-49]. One such technological advance that Pool contemplates is "digitization of the Harmonized Tariff Schedule" [Cl. 13, ln. 53-55]. In his transaction example for exporting an automobile, Pool includes, among others, "Import duties based on Tariff Classification of Goods class 8703.21.10 [Cl. 15, ln. 9-10]. Pool, however, never explains how one may go about determining that the correct HTS classification for an automobile is 8703.21.10 (for that matter, neither does any of the other art of record). In this particular case, indeed, one may be able to obtain the correct HTS classification without too much of a difficulty, as the HTS includes an entry for a motor vehicles (see Appendix A).<sup>1</sup>

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<sup>1</sup> Note that the 2004 edition of the HTSUS has no entry 8703.21.10, but only 8703.21.00, which corresponds to a passenger vehicle with spark ignition, internal combustion, reciprocating piston engine, of no more than 1000cc.

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However, there is a vast amount of products for which there is no entry in the HTS and/or ECCN. Rather, a person skilled in the HTS system must select a number for the item based on various characteristics of the item. In fact, depending on the item, the skilled HTS person must know which characteristics are of relevance to the HTS in order to create the appropriate HTS classification. Moreover, in many circumstances the broker must work together with a person skilled in the art of the technical aspects of the imported item, since 'knowledge of the imported item' many times requires specialized technical knowledge.

To fully understand this, Applicant submits the following example. Assuming that the item to be imported is a PLD (a term commonly used in the industry for a semiconductor chip forming a Programmable Logic Device). The entire HTS contains no entry for either a PLD nor a Programmable Logic Device. Thus, a person skilled in the electronic component art but not in the HTS system has no means to determine what is the appropriate HTS classification for a PLD - regardless of whether such a person uses a hard copy or a digital copy of the HTS. Conversely, a broker skilled in the HTS system but not the electronic component will also have difficulty determining the appropriate classification. This is why companies use import/export brokers who are skilled in the HTS classification in conjunction with technical personnel to work together and arrive at the appropriate classifications for the items imported.

In this example, the appropriate HTS classification for a PLD is 8542.21.8089 (See Appendix B). The system described and claimed in the subject Application automatically generates for the unskilled persons the appropriate HTS classification, thereby obviating the need to consult an export/import broker. That is, by mapping the HTS classification into a secondary classification set and generating the decision tree and questionnaire, the claimed system can generate the appropriate HTS classification, especially for persons skilled in the electronic component art, but not in the HTS art.

To be more specific, Applicant provides herein the manner in which the inventive system generates the HTS classification for a PLD. Qi indicates a question appearing on the computer screen, while Ai indicates a user's response. This is, in fact, the questionnaire that is constructed from the decision tree after a mapping has been made, for example, for an importer of various electronic components. That is, using knowledge

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of the HTS structure and electronic component art, the system used appropriate attributes of electronic components to generate a mapping of all of the relevant IITS classifications of electronic components, created decision trees, and created questionnaires for these decision trees. Then the system "walks" the user through the questionnaire in order to advance on the decision tree and issue a single, correct HTS classification.

Q1 – What category?

Choices available (according to tool customization):

Cable, Capacitors, Resistors, Integrated Circuit, Labels, Power Supply,  
Signal Generator, Transistor, Software and Media

A1 – Integrated Circuit (Attribute 1)

Q2 – What Type?

Possible Choices:

Monolithic IC, Smart Card, Hybrid IC, Part of an IC

A2 – Monolithic IC (Attribute 2)

Q3 – What Kind?

Possible Choices:

Digital, Analog or Mixed Signal

A3 – Digital (Attribute 3)

Q4 – Is the IC for HDTV and >100K gates?

Possible Choices:

Yes, No

A4 – No (Attribute 4)

Q5 – Select Appropriate

Possible Choices:

Un-mounted chips or dice or wafers, Packaged IC

A5 – Packaged IC (Attribute 5)

Q6 – Made of Silicon?

Possible Choices:

Yes, No

A6 – Yes (Attribute 6)

Q7 – Is it a Memory IC?

Possible Choices:

Yes, No

A7 – No (Attribute 7)

Q8 – What Type of IC?

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**Possible Choices:**

Microprocessor, Other (Controller or ASIC or PLA or PLD or etc)

A8 – PLD (Attribute 8)

Q9 – Select Appropriate Technology

**Possible Choices:**

TTL, ECL, Other Technology (e.g.: CMOS, etc)

A9 – Other Technology (Attribute 9)

**System Response: 8542.21.8089**

Classification Completed.

Importantly, unless the user is familiar with the HTS system, the user cannot arrive at this classification using the HTS (see Appendix B), since the appropriate page for this classification contains no mention of PLD. That is, the HTS lacks common terms used in the industry (e.g., PLD, CMOS, etc.), thereby making it difficult to arrive at the appropriate HTS classification. However, by mapping the HTS into a secondary classification, creating the decision tree, and creating the questionnaire, the system is able to generate a classification number for an unskilled user for items for which no entry is present in the conventional HTS. No such system is described or suggested by any of the cited art or any combination thereof.

Notably, according to some embodiments, (see, e.g., claim 4), the mapping is further enhanced by including additional description of the item. Such an additional description is made using terms that are familiar to the person skilled in the technical art of the imported item. For example, the regulatory terminology entry in the HTS “Automatic data processing machine” is changed in Applicant’s system to a new description “Computer” - a term which a person without regulatory knowledge can recognize. Similarly, Applicant’s system uses “Plastic label” to replace the description in the HTS reading “Self-adhesive plates, sheets, film, foil, tape, strip and other flat shapes, of plastic, whether or not in rolls”. In other cases, the regulatory terminology can actually be misleading. For example, the regulatory terminology for software is “recorded media”. It is easy to see that a software engineer at an importing company may have difficulty finding the appropriate HTS classification, as the term software can be found in the HTS in some but not in all relevant cases. The regulatory term, “recorded media” may be interpreted by the general public as applying only to things such as music

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CD's and movie DVD's and not encompassing software. Therefore, Applicant's system enhances this term using simply "software."

Under a proper analysis of obviousness under Section 103, the claim as a whole must be considered, and not just its various elements in isolation. See, e.g., MPEP 2141.02: "In determining the differences between the prior art and the claims, the question under 35 U.S.C. 103 is not whether the differences themselves would have been obvious, but whether the claimed invention as a whole would have been obvious." Here, looking at claim 1 as a whole, the claim recites a method for assigning an HTS or ECCN classification number to an item by first mapping classification numbers from the HTS or ECCN into a secondary classification set, building a decision tree for the mapped classification numbers in the secondary classification set, building a questionnaire for the decision tree, and assigning a single classification number according to the user's answers to the questionnaire. Nothing in the cited art or any combination thereof discloses or even remotely suggests such a system.

Indeed, in order to reject a claim under Section 103 the Examiner must first satisfy the three requirements establishing a *prima facie* case of obviousness. See, MPEP 2142: "To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations." Here, there's nothing in the prior art to suggest any of the combinations asserted by the Examiner. To the contrary, the two references that make mention of the HTS, i.e., Pool and Hoffer, never describe any problem or issue with assigning the correct HTS classification to an item. Both references simply assume that the user has knowledge of how to arrive at the correct classification. Therefore, neither provides a motivation to combine their disclosure with any of the other cited art. If any, Pool simply suggests that one may wish to digitize the HTS. Such a suggestion leads one to merely turn the hardcopy HTS into an electronic digitized reference – which is far removed from the claimed invention.

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For example, the Examiner's suggested motivation to combine the teachings of Rivette and Rofrano fails to satisfy the requirement under Section 103. That is, the Examiner alleges that the combination would help the customer to arrive at a product they would most likely be interested in. However, that is exactly what Rofrano teaches: a system of a product catalogue that helps customers find a product they will most likely be interested in. It is unclear, and respectfully submitted incomprehensible, how one skilled in the art would consider using the patent analysis tool of Rivette to improve on the system of Rofrano. Arguably, even if one would make such a postulation, it is unclear how one may find a likelihood of success in achieving such an improved system.

Similarly, even if one may wish to combine the disclosure of Pool and/or Hoffer with any of the other cited art, one fails to find a reasonable expectation of success for such a combination. That is, the other cited art, e.g. Rivette and Rofrano, disclose systems for handling definite data. That is, Rivette, for example, deals with patents – all of the data for which is known beforehand. Similarly, Rofrano deals with items available for purchase – the identity of all of which is known before hand. In contrast, neither the HTS nor the ECCN contain a list of all of the items a user may need to classify. Therefore, one cannot expect to be successful in implementing any of the combination suggested by the Examiner and arrive at a successful system for assigning an HTS or ECCN classification number to an item, since the identity of the item may not be known beforehand and may, indeed, not be even listed on the HTS and ECCN.

From the above discussion, it is clear that even if one makes the suggested combination, the resulting and combined disclosure still fails to disclose or suggest the claims' limitations. The most that can be argued is that the combined disclosure suggests digitizing the HTS and ECCN. That is, constructing an electronic version of the hardcopy versions of the HTS and ECCN. Such a combination would still necessitate referring to a skilled broker for determining classifications to various items, as exemplified above with respect to PLD and CMOS, both of which being conventional terms well known in the electronics art, but neither of which are listed in the hardcopy HTS and, therefore, neither of which will appear in a digitized version of an HTS.

Turning particularly to the claim's language and to the specific rejections, in order to make a prima facie case of obviousness under Section 103, the Examiner must show

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that every element recited in the claim is found or suggested by the prior art. See, MPEP 2143.03 "To establish *prima facie* obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art." However, the prior art fails to disclose or suggest various limitations of the claims. For example, claim 1 recites:

*A method for assigning a single classification number to an item from a list of classification numbers in one of the Harmonized Tariff System (HTS) and Export Control Commodity Number (ECCN)*

None of the art of record or any combination thereof discloses or suggests "a method for assigning a single classification number to an item from a list of classification numbers." Applying this language to Rivette, it would require the system of Rivette to accept an item, e.g., an inventive apparatus, and have the system classify the apparatus according to the patent classification. Nothing of the sort is disclosed or even remotely suggested by Rivette. Moreover, the claim's language is even more specific, i.e., it requires assigning a classification number of the HTS or ECCN to an item. Clearly no combination of the cited art discloses or suggests such a method.

More specifically, Rivette discloses a method for analyzing and visualizing patent data, but does not disclose or suggest assigning a classification number to an item. Similarly, Rofrano fails to disclose or suggest an assignment of classification number to an item, but rather discusses generating a questionnaire to arrive at various (rather than a single) merchandize items matching requests from a user. Pool and Hoffer, while disclosing the HTS and the HTS classification, fail to disclose or suggest any method for assigning a classification to a particular item.

In order to achieve the desired result, claim 1 specifically recites:

*presenting a user the questionnaire and obtaining the user's response to said questionnaire regarding a user's item to be classified*

Clearly none of the art or any combination thereof discloses or suggests this limitation. While arguably Rofrano presents a user with a questionnaire, that questionnaire does not obtain the user's response "regarding a user's item to be classified." Rather, the questionnaire relates to personal preference criteria of the user for selected items to be purchased, i.e., the end result is not the classification of an item as required by the claim



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but rather a group of items meeting the user criteria (the group may contain zero items, one item or many different items).

Claim 1 further requires:

*using the user's response to generate a single classification number from said secondary classification set for the user's item*

As understood by those skilled in the art, an item to be imported can have only a single classification number under the HTS. Every product imported into a country must have an HTS classification; there is only one correct classification for each commodity and assigning a different classification could result in penalties. Under Government regulations it is the importer's responsibility to ascertain the correct classification number for the item. This is why importers hire skilled brokers to correctly classify the item. Nothing of this sort is disclosed or suggested by the cited art or any combination thereof. While Pool shows a classification number for an automobile, Pool fails to provide any information as to how this number was arrived at.

As can be seen, at least for the reasons noted above, claim 1 is allowable over the cited art. Similar to claim 1, Claim 11 also recites: "A method for assigning a single tariff number from one of the Harmonized Tariff Schedule ("HTS") and Export Control Commodity Number (ECCN), to an item to be imported;" "mapping selected tariff numbers from one of the HTS and ECCN onto said secondary classification set;" and "wherein a user's response to said questionnaire leads to only a single tariff number from said secondary classification set." As argued above with respect to claim 1, none of the cited art or any combination thereof discloses or suggests these limitations. Accordingly, claim 11 is allowable as well. Since claims 12-18 depend from allowable claim 11, these claims are allowable as well by definition.

c. Claim 7 stands rejected under Section 103 as being unpatentable over Rivette et al in view of Rofrano and further in view of Pool. This rejection is respectfully traversed. As mentioned above, while Pool mentions the HTS system and discloses classification number for an automobile, Pool fails to explain how such classification number is arrived at and nothing in the disclosures of Rivette and Rofrano remedies this deficiency. Moreover, claim 7 specifies that the secondary classification set is a subset of the HTS

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and ECCN classification. Nothing in the cited art discloses or suggests such a feature. Accordingly, claim 7 is allowable.

d. Claims 19-21 stand rejected under Section 103 as being unpatentable over Rivette et al. in view of Hartman and further in view of Hoffer. This rejection is respectfully traversed. The Examiner asserts that Rivette discloses the limitation "said classification block having selected HTS tariff numbers mapped thereto..." This is clearly erroneous. Rivette nowhere even mentions the HTS or the ECCN. Rivette's entire disclosure relates to patents and companies, not HTS or ECCN. Similarly, while Hartman discloses a pricing system, it fails to disclose or suggest a decision tree enabling assignment of a single tariff number for an import item, as required by claim 19. Finally, while Hoffer makes use of the HTS numbers, it also fails to disclose or suggest how one arrives at these numbers. Accordingly, claim 19 is allowable over the cited art. Claims 20 and 21 depend from claim 9 and are, therefore, allowable as well by definition.

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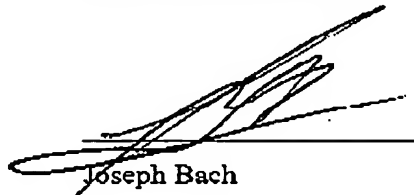
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**CONCLUSION**

It is respectfully submitted that the application is now in condition for allowance. If for any reason the Examiner finds that the Application is not in condition for allowance, the Examiner is invited to contact Joseph Bach at (408) 623-9466.

Applicants hereby petition for any extension of time that may be required to keep this Application in prosecution.

Respectfully Submitted



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APPENDIX A

# Harmonized Tariff Schedule of the United States (2004)

Amended for Statistical Reporting Purposes

XVI:  
87-6

Heading/ Subheading	Stat Suf- fix	Article Description	Unit or Quantity	Rates of Duty		
				General	Special	2
8703		Motor cars and other motor vehicles principally designed for the transport of persons (other than those of heading 8702), including station wagons and racing cars:				
8703.10		Vehicles specially designed for traveling on snow:				
8703.10.10	00	golf carts and similar vehicles:	No.	2.5%	Free (A+,B,CA,CL, D,E,I,L,J,JO,MX, SG)	10%
8703.10.50		Vehicles specially designed for traveling on snow				
		Other		2.5%	Free (A+,B,CA,CL, E,I,L,J,JO,MX,SG)	10%
	30	Golf carts	No.			
	60	Other	No.			
8703.21.00	00	Other vehicles, with spark-ignition internal combustion reciprocating piston engine:				
		Of a cylinder capacity not exceeding 1,000 cc	No.	2.5%	Free (A+,B,CA,CL, D,E,I,L,J,JO,MX, SG)	10%
8703.22.60	00	Of a cylinder capacity exceeding 1,000 cc but not exceeding 1,500 cc	No.	2.5%	Free (A+,B,CA,CL, D,E,I,L,J,JO,MX, SG)	10%
8703.23.00		Of a cylinder capacity exceeding 1,500 cc but not exceeding 3,000 cc		2.5%	Free (A+,B,CA,CL, D,E,I,L,J,JO,MX, SG)	10%
	10	Motor homes	No.			
		Other:				
		New:				
		Having engines with not more than 4 cylinders:				
		Station wagons and passenger vans:				
		Station wagons under 160 cm in height:				
	22	Of an interior volume not exceeding 2.8 m <sup>3</sup>	No.			
	24	Of an interior volume exceeding 2.8 m <sup>3</sup> but not exceeding 3.1 m <sup>3</sup>	No.			
	26	Of an interior volume exceeding 3.1 m <sup>3</sup> but not exceeding 3.4 m <sup>3</sup>	No.			
	28	Of an interior volume exceeding 3.4 m <sup>3</sup>	No.			
		Other:				
	32	Of an interior volume not exceeding 2.8 m <sup>3</sup>	No.			
	34	Of an interior volume exceeding 2.8 m <sup>3</sup> but not exceeding 3.1 m <sup>3</sup>	No.			
	36	Of an interior volume exceeding 3.1 m <sup>3</sup> but not exceeding 3.4 m <sup>3</sup>	No.			
	38	Of an interior volume exceeding 3.4 m <sup>3</sup>	No.			
	42	Other:				
		Of an interior volume not exceeding 2.4 m <sup>3</sup>	No.			

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APPENDIX B

## Harmonized Tariff Schedule of the United States (2004)

Known as for Statistical Reporting Purposes

XVI  
35-05

Heading/ Subheading	Stat. Suffix	Article Description	Unit or Quantity	Rates of Duty		2
				1	Special	
8542		Electronic integrated circuits and microassemblies; parts thereof:				
8542.10.00	00	Cards incorporating an electronic integrated circuit ("smart cards")	No.	Free		35%
8542.21		Monolithic integrated circuits:				
8542.21.40	00	Digital: For high definition television, having greater than 100,000 gates	No.	Free		35%
8542.21.80		Other		Free		35%
	00	Unmounted chips, dice and wafers:				
	10	Silicon	No.			
		Other	No.			
		Other:				
		Silicon:				
		Volatile memory:				
		Dynamic read-write random access (DRAM):				
	21	Not over 1 megabit	No.			
	22	Over 1 megabit but not over 8 megabits	No.			
	23	Over 8 megabits but not over 16 megabits	No.			
	24	Over 16 megabits but not over 64 megabits	No.			
	25	Over 64 megabits but not over 128 megabits	No.			
	29	Over 128 megabits	No.			
		Static read-write random access (SRAM):				
	31	Not over 256 kilobits	No.			
	32	Over 256 kilobits but not over 2 megabits	No.			
	39	Over 2 megabits	No.			
		Other memory:				
		Electrically erasable programmable read-only memory (EEPROM):				
	41	Not over 64 kilobits	No.			
	42	Over 64 kilobits but not over 512 kilobits	No.			
	49	Over 512 kilobits	No.			
		Erasable (except electrically) programmable read-only memory (EPROM):				
	51	Not over 64 kilobits	No.			
	52	Over 64 kilobits but not over 512 kilobits	No.			
	59	Over 512 kilobits	No.			
	60	Other	No.			

## Harmonized Tariff Schedule of the United States (2004)

Annotated for Statistical Reporting Purposes

XVI  
85-88

Heading Subheading	Stat. rate	Article Description	Unit or Quantity	Rates of Duty		2
				General	Special	
8542 (con.)		Electronic integrated circuits and microassemblies; parts thereof (con.):				
8542.21 (con.)		Monolithic integrated circuits (con.):				
8542.21.80 (con.)		Digital (con.):				
		Other (con.):				
		Other (con.):				
		Silicon (con.):				
		Other, including microprocessors, controllers, application specific integrated circuits (ASIC), and programmable logic arrays (PLA):				
		Microprocessors having an internal data bus of:				
	71	8 bits or less	No.			
	72	16 bits	No.			
	79	32 bits or more	No.			
		Other:				
	81	Transistor-transistor logic (TTL)	No.			
	82	Emitter-coupled logic (ECL)	No.			
	89	Other	No.			
		Other than silicon:				
	91	Memory	No.			
	99	Other	No.			
8542.29.00	10	Other	No.	Free		35%
		Unmounted chips, dice and wafers	No.			
	20	Other:				
		With an operating frequency not less than 100 MHz	No.			
		Other:				
	30	Mixed signal (analog/digital):				
	40	Logic	No.			
	50	Other	No.			
8542.60.00	75	Other	No.	Free		35%
		Hybrid integrated circuits				
	95	With an operating frequency not less than 30 MHz	No.			
8542.70.00	00	Other	No.			
8542.90.00	00	Electronic microassemblies	No.	Free		35%
		Parts	X	Free		35%